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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,842	02/11/2002	Arturo A. Rodriguez	A-7496	6628
5642	7590	08/02/2004	EXAMINER	
SCIENTIFIC-ATLANTA, INC. INTELLECTUAL PROPERTY DEPARTMENT 5030 SUGARLOAF PARKWAY LAWRENCEVILLE, GA 30044			BUI, KIEU OANH T	
			ART UNIT	PAPER NUMBER
			2611	
DATE MAILED: 08/02/2004				

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/073,842	RODRIGUEZ ET AL.
	Examiner	Art Unit
	KIEU-OANH T BUI	2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 27 May 2004.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 105-132 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 105-115 and 122-132 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) 116-121 are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All    b)  Some \* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date.       .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other:       .

**DETAILED ACTION*****Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/27/04 has been entered.

***Remark***

2. Claims 1-104 were canceled in the amendment no 12 (dated 5/24/04). Pending claims are new claims 105-132.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

4. Claim 107 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "more than an hour" in claim 107 is a relative term which renders the claim indefinite. The term "more than an hour" of intermittent time intervals is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Simple reason is a time of two hour or ten hour or a month does meet this relative term, which renders the claim indefinite.

***Election/Restrictions***

5. Newly submitted claims 116-121 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: a method implemented by a television set top terminal (STT) *with the determination step of whether a television is on and responsive to outputting the advertisement and by using a counter for counting advertisements outputs by the STT therein.*

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 116-121 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless --*  
*(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.*

7. Claims 105-115, and 122-132 are rejected under 35 U.S.C. 102(e) as being anticipated by Ozer et al. (U.S. Patent Pub No. US2003/0101454 A1/ or “Ozer” hereinafter).

Regarding claim 105, this limitation is met as Ozer discloses a method implemented by a television set top box or set top terminal (STT) comprising the steps of outputting to a television by the STT a graphical user interface (GUI) configured to identify advertisement categories, and under a user input at the STT for identifying or selecting a category of advertisements at the STT, the corresponding advertisements are downloading to the STT responsive to the user input (see Fig. 8 and page 2/section 0019 for an overview of a receiver device, such as a set top box; page 14/sections 0141, 0142, 0143 for the advertisement data is stored in category order, and based on the user input for advertisement contents, the advertisement contents corresponding to an interested category is displayed to the user, see more at page 18/section 0178 and page 19/section 0182).

Ozer further discloses that advertisement category having a first advertisement category and a second advertisement category, and the user provides a first and a second input corresponding to the first category and the second category, and after receiving the first and second user inputs, outputting to the television by the STT the corresponding advertisements of the first and the second advertisement category at a first and second future time during an interruption in a television presentation being output by the STT (page 2, section 0020 & page 5/section 0051 & 0055 for time of advertisement display can be any time as “flexible advertisement” as well as advertisement categories can be preset or selected by the users (page 9/section 0091 and page 11/section 0108 as the user can select the areas of preferences); and future schedules of advertisement can also be set (page 6/section 0066) based on a number of times (page 7/section 0070). Ozer clearly discloses that the advertisement can be displaying at any time or future time at any day, week, month based on attributes or user’s demographics to target right users at different (right) times (page 8/section 0078 & 0079 & 0080). Moreover, Ozer discloses further comprising outputting the advertisement to a television during an interruption in a television program, or in other words, between portions of broadcast programming and at predetermined time periods (pages 16-17, sections 0161 & 0162 as the advertisements can be scheduled at any time at various different locations).

As for claim 106, this limitation is met as Ozer shows in Fig. 1 & 2 that a control module 16 interacts with the users at receiver module 20, which receives the user inputs at a database, as shown with (database) historical data 46 (see further on page 7/section 0070-0072).

As for claim 107, in further view of the rejection 112-2<sup>nd</sup> above, this limitation is met as Ozer notes that the multiple advertisements (more than two) can be displaying intermittent time intervals at preset times within any day, week, or month or in the morning and then in the afternoon—more than one hour (page 8/section 0078-0080) and the frequency of (time) display (page 10/section 0095 to section 0098).

As for claim 108, this limitation is met as Ozer discloses that based on the scheduled time, the advertisement can only be targeted to right viewers based on their preferences and profiles from the receiver module or the user (page 2/section 0020-0021).

As for claim 109, this limitation is met as Ozer discloses a technique of tracking the displayed advertisements or previously viewed advertisements (page 6/section 006 for tracking advertisements; and page 14/section 0144 for previously viewed advertisements with offering to other choices); and Ozer discloses that user interaction for advertisement content is recorded in a log as means for identifying that at least a portion of the advertisement was viewed by the user (Fig. 9, step 334 through step 342, and page 19, section 0181 & 0182).

As for claim 110, this limitation is met as Ozer discloses further comprising outputting the advertisement to a television during an interruption in a television program, or in other words, between portions of broadcast programming and at predetermined time periods (pages 16-17, sections 0161 & 0162 as the advertisements can be scheduled at any time at various different locations).

As for claim 111, this limitation is met as Ozer further discloses that various attributes associated with groups of the advertisement contents as the subcategory of advertisements that correspond to respective broader categories (page 9/section 0091 for targeted genre and further

additional dimensions that define various properties and attributes of target criteria as “subcategory”).

As for claims 112 and 113, these limitations are met as Ozer further discloses that advertisements has defined duration display times, and they are stored within the receiver 20 or the set top terminal (page 17/section 0162 & 0176, and being removed after the predefined period (as illustrated in Fig. 9, step 336).

As for claims 114 and 115, these limitation are met as Ozer discloses that as soon as the user click through or viewed the advertisements, the advertisement can be removed based on the log of committed advertisements using the weight value as a measurement of user activities whether to select the advertisements for viewing or not (page 18/section 0178 to page 19/section 0182).

As for claims 122-132, these claims with same limitations are rejected for the reasons given in the scope of claims 105-115 as disclosed in details above.

### *Conclusion*

**8. Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

**(703) 872-9306, (for Technology Center 2600 only)**

*Hand-delivered responses should be brought to Crystal Park III, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).*

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krista Kieu-Oanh Bui whose telephone number is (703) 305-0095. The examiner can normally be reached on Monday-Friday from 9:00 AM to 6:30 PM, with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant, can be reached on (703) 305-4755.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.



KRISTA BUI  
PATENT EXAMINER

Krista Bui  
Art Unit 2611  
July 28, 2004